

ESTTA Tracking number: **ESTTA738849**

Filing date: **04/08/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91226617
Party	Defendant Stressbar Systems International LimitedLiability CompanyLiability Company
Correspondence Address	ANTONIO GUTIERREZ PLATA FERRER & GUTIERREZ LLC 7000 BOULEVARD EAST STE M-21A GUTTENBERG, NJ 07093-4814 UNITED STATES agutierrez@plataferrer.com;mferrer@plat
Submission	Answer and Counterclaim
Filer's Name	Kate A. Sozio
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Signature	/Kate A. Sozio/
Date	04/08/2016
Attachments	Stressbar Systems International, LLC's Answer to Notice of Opposition & Counterclaim.pdf(39005 bytes )

Registration Subject to the filing

Registration No	621637	Registration date	02/21/1956
Registrant	NIAGARA LASALLE CORPORATION 1412 E. 150TH STREET HAMMOND, IN 46327 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 006. First Use: 1937/02/00 First Use In Commerce: 1937/02/00 All goods and services in the class are requested, namely: STEEL
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application No.: 86/189,035  
Published in the *Official Gazette* September 1, 2015

_____	:	Opposition No.
NIAGARA LASALLE	:	
CORPORATION,	:	91226617
	:	
	:	
OPPOSER,	:	
	:	
V.	:	
	:	
STRESSBAR SYSTEMS	:	
INTERNATIONAL, LLC	:	
	:	
	:	
APPLICANT.	:	
_____	:	

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**APPLICANT STRESSBAR SYSTEMS INTERNATIONAL, LLC’S ANSWER TO  
NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES AND COUNTERCLAIM**

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Applicant, Stressbar Systems International, LLC (“Applicant” or “Stressbar”), by and through its undersigned counsel, hereby sets forth its Answer, Affirmative Defenses and Counterclaim to Opposer Niagara LaSalle Corporation’s (“Opposer”) Notice of Opposition against Applicant’s application for registration of Stressbar’s trademark STRESSBAR, Serial No. 86/189,035 filed February 10, 2014 and published in the Official Gazette on September 1, 2015 (the “Mark”) as follows:

As to the first unnumbered paragraph of the Notice of Opposition, Applicant admits only that its application for registration, Serial No. 86/189,035 has been published in the *Official*

*Gazette* in International Classes 06, 37, and 40 in connection with the listed goods and services. Applicant denies each and every other allegation contained in the first unnumbered paragraph of the Notice of Opposition, including the argumentative assumption that Opposer has been, or will be, damaged by the registration of STRESSBAR.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in this Paragraph and therefore, denies same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in this Paragraph and therefore, denies same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in this Paragraph and therefore, denies same.

4. Denied.

5. Denied.

6. Denied.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

Opposer fails to state a claim upon which relief can be granted.

#### **Second Affirmative Defense**

There is no likelihood of confusion, mistake, or deception because the Mark and the alleged trademark of Opposer are not confusingly similar.

#### **Third Affirmative Defense**

Alternatively, any similarity between the Mark and Opposer's alleged trademark is restricted to that portion of the Mark consisting of the word "stress," which is not distinctive. As a result, under the Antidissection Rule any secondary meaning Opposer may have in its alleged

STRESSPROOF trademark is narrowly circumscribed to protect only the exact trademark claimed by Opposer and does not extend to any other feature of the alleged trademark STRESSPROOF besides the word “stress.”

#### **Fourth Affirmative Defense**

Opposer’s rights in and to the portion of its alleged STRESSPROOF trademark has become a generic term used to describe goods similar to those sold by Opposer.

#### **COUNTERCLAIM TO CANCEL REGISTRATION**

1. Applicant repeats and realleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

2. Applicant hereby seeks cancellation of Opposer’s Registration (Registration No. 0621637) issued February 21, 1956 for the mark STRESSPROOF in International Class 006 for the application filed April 22, 1955.

3. On information and belief, Opposer is and has been using the mark STRESSPROOF in connection with carbon-manganese grade steel with high tensile properties.

4. The term “stressproof” is, or has become, a generic term universally used by steel manufacturers and purchasers and others in the relevant public to describe carbon-manganese grade steel with high tensile properties.

5. The fact that Opposer, or its predecessor in interest, obtained a federally registered trademark in 1956 does not now entitle Opposer to monopolize a generic term of common usage within the steel manufacturing industry to describe carbon-manganese grade steel with high tensile properties.

6. For the foregoing reasons, Applicant believes it will be damaged by the continued maintenance on the Principle Register of the alleged trademark STRESSPROOF and that therefore Registration No. 0621637 should be cancelled.

Applicant is filing by credit card the statutory filing fee of \$300.00 for its counterclaim for cancelation.

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WHEREFORE, Applicant prays as follows:

- (a) this opposition be dismissed;
- (b) that Registration No. 0621637 be cancelled; and
- (c) a registration for the term STRESSBAR be issued to the Applicant.

Respectfully submitted,

By: /s/ Joel G. MacMull  
Joel G. Macmull

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*Attorneys for Applicant*  
*Stressbar Systems International, LLC*

Dated: April 8, 2016.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 8<sup>th</sup> day of April, 2016, a true copy of the foregoing ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM was served on counsel for the Opposer by sending the same via U.S. First Class mail, postage prepaid, and emailed to:

Dennis S. Prah  
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[dprahl@ladas.com](mailto:dprahl@ladas.com)

**CERTIFICATE OF ELECTRONIC FILING**

The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 8th day of April, 2016.

By: /s/ Joel G. MacMull  
JOEL G. MACMULL